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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/997,515 | 11/29/2001 | Peter J. Armbruster | IR105459 | 5017 |

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EXAMINER

PEACHES, RANDY

ART UNIT PAPER NUMBER

2617

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/997,515 | ARMBRUSTER ET AL. | |
| | Examiner | Art Unit | |
| | Randy Peaches | 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/06 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. **Claims 2-19 and 21** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 4, 19 and 24** of U.S. Patent Publication No. **20030100302**. Although the conflicting claims are not identical, they are not patentably distinct from each other because together they render the same inventive practice/procedures. The Examiner would like to bring to the Applicant's attention that the referenced application, U.S. Patent Publication No. **20030100302**, has been allowed and therefore; according to the cited portion of the MPEP below, the cited rejection to the instant application is applicable.

(a) One-Way Obviousness

If the application at issue is the later filed application or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application **>*would have been~~<~~ an obvious variation of the invention defined in a claim in the patent. See, e.g., *In re Berg*, *>*140 F.3d 1438,*<* 46 USPQ2d 1226 (Fed. Cir. 1998) (the court applied a

one-way test where both applications were filed the same day). If a claimed invention in the application **>*would have been~~<~~ obvious over a claimed invention in the patent, there would be an unjustified timewise extension of the patent and an obvious-type double patenting rejection is proper. Unless a claimed invention in the application **>*would have been~~<~~ obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made, but this does not necessarily preclude a rejection based on another type of nonstatutory double patenting (see MPEP § 804, paragraph II.B.2. below).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 2-3, 5-8, 11-13, 15-17 and 21*** are rejected under 35 U.S.C. 102(e) as being anticipated by Gentry (U.S. Patent Number 6,453,162 B1).

Regarding ***claims 2 and 12***, according to ***claims 21 and 11***, Gentry discloses in column 5 lines 29-32, wherein the said personal computer (48), which reads on claimed "DHLR," is not located at the telecommunication service provider. The Examiner would like to bring to the Applicant's attention the cited portions in the Applicant's specification, wherein it is clearly evident on page 3 lines 27-29 wherein the said personal or distributed HLR can be a personal computer.

Regarding ***claims 3 and 13***, according to ***claim 2 and 12***, wherein, as disclosed by Gentry in column 3 lines 63-64, wireless subscribers, which reads on claimed "plurality of users", each said user of the said wireless subscribers having a said personal computer (48) coupled to a said WEB server (44) indicating the services available to the said user.

Regarding **claims 5 and 15**, according to **claims 21 and 11**, wherein Gentry discloses in column 5 lines 20-24, the said foreign network (16) includes a remote HLR, as described in column 1 lines 48-54 and column 6 lines 10-14 wherein the referenced remote HLR is a second HLR, for generating a message requesting approval of the agreement by the said personal computer (48). See column 5 lines 54-67 and FIGURE 3.

Regarding **claim 6**, according to **claim 21**, wherein, as disclosed by Gentry in column 5 lines 43-67, a said personal computer (48) includes a WEB server (44), which reads on claimed "mean", for generating an IS-41 messages, which reads on claimed "message", requesting the approval of the agreement by the subscriber station (12) of the user.

Regarding **claims 7 and 16**, according to **claims 21 and 11**, wherein, as taught by Gentry in column 5 lines 22-42, the said personal computer (48) coupled to the said WEB server (44) includes a computing device.

Regarding **claims 8 and 17**, according to **claims 21 and 11**, as disclosed by Gentry in column 6 lines 10-30, wherein the communication network includes an internet connection between the said personal computer (48) and the remote wireless component (20), which reads on claimed "VLR" (see column 6 lines 10-13 and FIGURE).

Regarding **claim 11**, Gentry discloses arrangement for services in a foreign network (16) by a user of a home network (10) comprising:

- a home network including a home location register (HLR, 17) coupled to the communication network. See column 4 lines 20-40 and FIGURE 2.
- a personal computer (48) coupled to a WEB server (44), which reads on claimed "distributed home location register (DHLR)", including data for authorizing the services in the foreign network (16). See columns 5 and 6 lines 22-42 lines 24-27;
- the said foreign network (16) including a wireless component (20), e.g. visitor location register (VLR, 20)(see column 6 lines 10-13), for determining an agreement for the services that are needed by the user in the said foreign network (16). See FIGURE 1, columns 4 and 5 lines 51-67 lines 1-4, respectively. Additionally, the said foreign network (16) includes a remote HLR, as described in column 1 lines 48-54 and column 6 lines 10-14 wherein the referenced remote HLR is a second HLR, for generating a message requesting approval of the agreement by the said personal computer (48). See column 5 lines 54-67 and FIGURE 3; and
- a subscriber station (12) which reads on claimed "mobile device", of the user coupled to the said foreign network (16) for approving the agreement for the services; See column 6 and 7 lines 55-67 lines 1-13.

- a communication network for coupling the said personal computer (48) to the said wireless component (20). See columns 6 lines 10-30 and FIGURE 2.

Regarding **claim 21**, Gentry discloses a mobile communication system comprising (See FIGURE 1):

- an Internet (46) and an IS-41 Network (40), which reads on claimed "communication network." See FIGURE 2.
- a home network coupled to the said communication network. See FIGURE 1;
- foreign network coupled to the said communication network. See FIGURE 1;
- a home network including a home location register (HLR, 17) coupled to the communication network. See column 4 lines 20-40 and FIGURE 2; a personal computer (48) coupled to a WEB server (44), which reads on claimed "distributed home location register (DHLR)", including data for authorizing the services in the foreign network (16). See columns 5 and 6 lines 22-42 lines 24-27;
- the said foreign network (16) including a wireless component (20), e.g. visitor location register (VLR, 20)(see column 6 lines 10-13), for determining an agreement for the services that are needed by the user in the said foreign network (16). See FIGURE 1, columns 4 and 5 lines 51-67 lines 1-4, respectively. Additionally, the said foreign network (16) includes a remote HLR, as described in column 1 lines 48-54 and column 6 lines 10-14 wherein the referenced remote HLR is a second HLR, for generating a message requesting

approval of the agreement by the said personal computer (48). See column 5 lines 54-67 and FIGURE 3; and

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claims 4 and 14*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry (U.S. Patent Number 6,453,162 B1) in view of Torabi (U.S. Patent Number 6,754,482 B1).

Regarding ***claims 4 and 14***, according to ***claims 3 and 13***, wherein, as disclosed by Gentry in column 3 lines 63-64, wireless subscribers, which reads on claimed "plurality of users", each said user of the said wireless subscribers having a said personal computer (48) coupled to a said WEB server (44) indicating the services available to the said user.

However, Gentry fails to clearly teach wherein a first network HLR for a particular user includes a pointer to the DHLR for a particular user.

Torabi teaches in column 4 lines 38-55 wherein a user maybe traveling and authorized to receive a certain service within a particular area, on a pre-authorized

basis. When the user originates a request for a service while in this area, it is further determined from that this service is authorized. Therefore, it is known that the HLR, via the subscriber's profile, recognizes where the subscriber's said DHLR location when the service is requested in a particular pre-authorized area.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gentry (U.S. Patent Number 6,453,162 B1) in view of Torabi (U.S. Patent Number 6,754,482 B1) in order for the system to recognize the user's said DHLR when provisioning service in a foreign location, which in turn, decrease the authorization processing time due to the system recognizing the user's location and providing the requested service based on the pre-authorization.

3. ***Claims 9-10 and 18-19*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry (U.S. Patent Number 6,453,162 B1) in view of well known prior art (MPEP 2144.03).

Regarding ***claims 9-10 and 18-19***, according to ***claim 21 and 11***, Gentry teaches of a communication network where a said personal computer (48) is connected to a said wireless component (20) of a said foreign network via the internet. Gentry, does not expressly disclose having a wireless or wire line connection between the VLR and the DHLR as claimed.

The examiner takes official notice that using the wireless or wire line connection to communicate between a mobile subscriber and a network component was well known in the art of telecommunications.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a wireless or wire line connection in Gentry in order to have a flexible way of implementing a transmission medium between the personal computer (48) and the said wireless component (20).

Response to Arguments

Applicant's arguments with respect to claims 2-19 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claims 2-19 and 21, the Applicant argues that the cited prior art of Gentry fails to clearly render support of a said DHLR. Consequently, as cited in the above office action, the Applicant contends in the Specification on page 3 lines 27-29, the a DHLR or personal HLR can be a personal computer with an interface to a network. The Examiner maintains that Gentry reads on the claimed language.

With respect to the 103 rejection, the Examiner has shown how/where the combination of Gentry US 6,453,162 and Torabi US 6,754,482 B1 read on the claimed limitations. The examiner is not swayed by the current arguments, in fact, they appear to attack the references individually when a USC 103 combination has been put forth. Please remember that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Peaches
July 6, 2006


CHARLES APPIAH
PRIMARY EXAMINER